

III. REMARKS

Claims 1-5, 7-13, 15, 17-32 and 34 are not unpatentable over Byrne on view of Huang. The combination of Byrne and Huang does not teach that the "information" is based on one of a requested content, a requested access point number, a requested uniform resource location (URL) and a requested internet protocol (IP) address as is claimed by Applicant.

The Examiner acknowledges that this feature is not disclosed by Byrne. Huang does not overcome this deficiency. While the Examiner refers to Col. 3, lines 35-40 of Huang, neither this section nor any other portion of Huang discloses this feature.

Huang refers to transmitting an "address resolution protocol (ARP) request packet" from the node MT1 to the node LES1. (Col. 3, lines 38-40). The request packet includes the IP address of the destination node s4. (Col. 3, lines 39-40). The above only relates to a desire of a node on a first VLAN (e.g. MT1) to communicate with a node on a different VLAN (e.g. node s4), (Col. 3, lines 36-38). There is no disclosure here, or anywhere else in Huang, related to "performing an intersystem handover" as is claimed by Applicant. The assembly of a packet, including a header with the IP address of a source node (MT1) and an IP address of a destination node (s4), and the routing of this packet to the destination node identified by the corresponding IP address, as described in Huang, is not what is being claimed by Applicant.

Applicant claims "performing an intersystem handover of a mobile terminal." The "intersystem handover" is initiated by transmitting from the mobile to the communication network "information" that indicates "an intersystem handover" from a

radio network of a first type to a radio network of a second type should be performed. The "information" is based on either the requested content, a requested access point identifier, a requested resource location or a requested internet protocol address. Huang does not disclose or suggest use of "information" related to an "intersystem handover" as is claimed by Applicant.

Thus, since neither Byrne nor Huang discloses or suggests initiating an "intersystem handover" by transmitting "information" that an "intersystem handover" is to be performed and that the "information" is based on one of a requested content, a requested access point number, a requested resource location and a requested internet protocol address their combination cannot as well. Thus, the claims are patentable over the combination of Byrne and Huang.

It is also submitted that there is no motivation to combine Byrne with Huang for purposes of 35 U.S.C. § 103(a). "Motivation" requires that there must be some suggestion, either in the references themselves or within the knowledge available to one of ordinary skill in the art, to modify or combine the references. (See e.g. M.P.E.P. §2142). Neither Byrne nor Huang provide this requisite "suggestion" as is required.

Byrne discloses an explicit initiation of a handover by a mobile terminal. (Col. 7, line 61 to Col. 8, line 14). In Byrne it is stated that "intersystem" knowledge of the location of CCTs 200 will facilitate handover during calls. (Col. 8, lines 5-6).

Huang also discloses an explicit handover message for causing an intra-system handover. In Huang, during the "handoff procedure" one node transmits a "handoff message" to the other node. However, there is no disclosure in either Byrne or Huang, and

there is no motivation to modify Huang as proposed, that a handover is initiated based upon the transmission of "information" that is based on an IP address as claimed.

Huang discloses a transmission of an ARP request packet including an IP address by a mobile terminal MT1. The IP address is used for determining the VLAN to which the node having the indicated IP address belongs and enabling a correct routing by means of an address translation (Col. 3, lines 35-55). This has no similarity to an intersystem handover. This is also apparent from the fact that when using the method of claim 1, a regular (or special as in Huang) routing of packets to a selected IP address has obviously to be performed in addition to the proposed handover. Thus, Huang also discloses an explicit handover message.

There is no link between the IP address used by Huang for the regular routing of packets and the "control signals" to facilitate handover in Byrne.

Byrne discloses the explicit initiation of a handover and one would not look to Huang, which only discloses the regular routing of packets based on an included IP address, to derive a method for initiating a handover based upon the transmission of "information" as claimed by Applicant. There is no suggestion or teaching in either Huang or Byrne, or in the knowledge generally available to one of skill in the art to use IP address information, not having any relation to a handover, as an option for the implicit initiation of a handover, as an alternative to the explicit handover operations proposed by both Byrne and Huang. Any suggestion that motivation exists to combine these references for purposes of achieving Applicant's claims can only be made with hindsight knowledge of the claims, since neither

relates to using "information" as claimed by Applicant to initiate a handover.

Thus, since neither Byrne nor Huang provide the required "motivation" to combine references for purposes of 35 U.S.C. §103(a), a prima facie case of obviousness cannot be established.

Furthermore, Applicant respectfully notes that Byrne and Huang have been combined improperly. References may be combined under 35 U.S.C. §103(a) only if references are analogous art. In this case, Byrne and Huang are not analogous art. A reference is analogous art if:

- 1) The reference is in the same field of endeavor as the applicant's, or
- 2) The reference is reasonable pertinent to the particular problem with which the applicant was concerned.

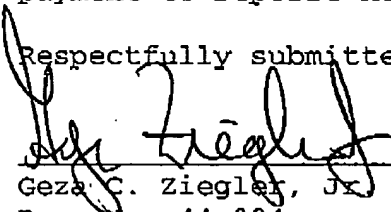
Byrne relates to handovers where "inter system knowledge of the location of the CCTs 200 will facilitate handover during calls." (Col. 8, lines 5-6). Huang teaches that the nodes "execute a handoff procedure whereby the node MT3 first transmits a handoff message to the node BS2." (Col. 4, lines 23-25). Neither of these teachings have a relationship to what is claimed by Applicant, which is to initiate intersystem handover by transmitting "information" that is based on one of a request content, a requested access point number, a requested uniform resource location and a requested internet protocol address as is claimed. Thus, the references cannot be combined and the claims should be allowable.

Point 5 of the Examiner's "Response to Argument" only discusses the regular routing of packets based on an included IP address. What is missing here is the relationship to initiating a handover. There is no link between the IP address used by Huang for packet routing and the handover message of Byrne. Applicant's claims recite intersystem handover with respect to the "information". There is no such disclosure or teaching in Huang. Thus, Huang is clearly deficient in this regard and the rejection cannot stand on this basis.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,


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19 May 2006
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